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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/064,351

Applicant(s)

CHAN, CHI KUEN

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in China on 12/12/2001. It is noted, however, that applicant has not filed a certified copy of the Chinese application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 6, 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Maddrell et al (US 6041215).** Maddrell et al teaches a talking book including: a book with a cover and pages that include pictures (col. 7: 1- 5); a speech circuit that reads aloud information about the pictures in the book; the speech circuit comprising: a printed circuit board containing speech switches, the printed circuit board being inside the cover of the book (Figure 18, 182 and col. 7: 32-35); a speaker (Figure 18, 114); a battery (Figure 19, 112) connected to power the printed circuit board and speaker; and a circuit for storage and sound emission connected to the printed circuit board, speaker and battery, wherein the circuit for storage and sound emission, the speaker, and the battery are stored in a box-like container outside the book (the electronics module, Figure 19, 106), and the circuit for storage and sound emission stores recorded sounds of the book, such that in response to a user pressing on a picture on a selected page, a corresponding one of the speech switches will be switched on, which causes the circuit for storage and sound emission to cause the speaker to read aloud specified contents about the pressed

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picture (col. 7:43-49), as in **claim 1** and substantially similar language in **claim 12**. The book of Maddrell is a "board book" which, by definition, is a hard cover book (**claim 6**), see col. 9:52-55. The box-like container is connected to the book in a fixed manner (**claim 8**), see Figure 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 2-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddrell et al (US 6041215) in view of Weiner (US 4778391).** In addition to the above Maddrell et al teaches the printed circuit board including a substrate made of a durable soft film and containing the switches (**claim 3**), see col. 5: 5, col. 7: 33-35, and col. 10: 39-53. Maddrell et al fails to teach the printed circuit board including a plurality of press trigger switches and each page of the book including a respective page selection contact corresponding in position to a respective one of the press triggers for page selection, wherein in response to a user turning to a certain page, pressing its page selection contact to turn on the corresponding press trigger switch, and then pressing a picture on the certain page to turn on the corresponding speech switch, the speech circuit causes the speaker to read aloud words corresponding to the pressed picture on the certain page (**claim 2**) and the page selections being placed in the margins of every page and the location of each page selection contact on each page is different from the locations

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of other page selection contacts for other pages (**claim 4**). Weiner et al teaches these aspects in col. 3: 54-61 and col. 4: 26-54, respectively. It would have been obvious to one of ordinary skill in the art to incorporate the specific page selection option of Weiner into the Maddrell system so as to ensure that the user receives the audio associated with the proper page.

**4. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddrell et al (US 6041215).** Maddrell fails to specifically teach that the circuit for storage and sound emission includes an IC block HE80320 or HE167430 (**claim 5**) or that the box-like container has an appearance of a pencil box, a candy box or a dressing case (**claim 7**). It is the examiner's position that the specific choice of circuitry components or outward appearance of an object is a matter of design choice. As the applicant has shown no clear advantage or unexpected result of the above, it would have been obvious to one of ordinary skill in the art to use any IC block in creating the circuitry for the Maddrell et al system. Similarly any outward appearance or shape could be given to the components without departing from the heart of the invention and merely modifies the aesthetics of the invention.

**5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddrell et al (US 6041215) in view of Billings (US 5404444).** Maddrell teaches all aspects of the invention as shown above with respect to claim 1, but fails to specifically teach that the sentences being read are in different voices and tones depending on the page being read. Billings clearly teaches this limitation in col. 4: 36-60. It would have been obvious to one of ordinary skill in the art to incorporate this feature into the Maddrell et al system so as to retain the user's interest (col. 4: 60 of Billings).

**6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddrell (US 6041215) in view of Li (US 5631883).** Maddrell teaches all aspects of the invention as shown above with respect to claim 1, but fails to specifically teach that the speech circuit includes a stop contact on every page. Li teaches this feature in col. 4: 49-52. It would have been obvious to one of ordinary skill in the

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art to incorporate this feature into the Maddrell system so as to allow the user great convenience and freedom reader, as taught by Li in col. 4: 52-56.

7. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddrell (US 6041215) in view of Burrows et al (US 5413481).** Maddrell teaches all aspects of the invention as shown above with respect to claim 1, but fails to specifically teach that the language is recorded in a plurality of languages where the language is selectable by the user. Burrows et al teaches this feature in an interactive book in col. 5: 22-32. It would have been obvious to modify the Maddrell system to include the selectable language functionality of Burrows et al so as to allow the Maddrell system to be used in teaching foreign languages.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. DeSmet (US 4884974) teaches a talking book with a separate memory assemble, includes playback synchronization with pages
  - b. Brefka et al (US 4636881) teaches a talking book seperated from the media associated therewith
  - c. Ipcinski et al (US 4818827) teaches the type of switches commonly used in Talking Books
  - d. McClanahan (US 5290190) teaches a talking book with sensors in each page
  - e. Kallmann (US 2945307) teaches a talking book which uses magnetic media
  - f. Cummings (US 4990092) teaches a talking book with page sensors
  - g. DE 3140735 A1, from abstract teaches a talking book which may include multiple languages

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen M Christman  
Examiner  
Art Unit 3713

September 2<sup>nd</sup>, 2004